

REMARKS

In the Office Action the Examiner noted that claims 1-11 are pending in the application, and the Examiner rejected all claims. By this Amendment, claims 1-8 have been amended. No new matter has been presented. Thus, claims 1-11 remain pending in the application. The Examiner's rejections are traversed below, and reconsideration of all rejected claims is respectfully requested.

Claim Rejections Under 35 USC §103

On pages 3-7 of the Office Action the Examiner rejected claims 1-2, 4-5, and 7-11 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,052,709, issued to Paul (hereinafter referred to as "Paul") in view of U.S. Patent No. 6,757,830, issued to Tarbutton et al. (hereinafter referred to as "Tarbutton"). The Applicants respectfully traverse the Examiner's rejections of these claims.

Claim 1 of the present application, as amended, recites "registering a second address as a receiver address in an address table for mail virus detection, and a corresponding first address in a respective client mail address book, for each of a plurality of clients of the local mail system." In other words, each client of the local mail system has a first address, which corresponds to a second address registered in the mail virus detection address table, registered in its mail address book. The Applicants respectfully submit that neither of the cited references, either alone or in combination, discloses or suggests at least these features of claim 1.

Paul discloses a method of detecting unsolicited (spam) electronic mail by creating and planting one or more spam probe email addresses at various sites on a communications network (Column 1, Lines 60-64). When an electronic mail is addressed to one of these spam probe email addresses, a spam control center automatically analyzes the received electronic mail to identify the source of the message, extracts and processes the source data from the received message, and generates an alert signal containing the processed source data (Column 2, Lines 1-6). Therefore, the spam emails are addressed to email addresses which are not used by clients, and are only intercepted when incoming to the clients of the system. None of the spam probe email addresses are registered in a mail address book of the clients of the system. The Examiner stated that the sender of the spam email in Paul is a client, and that client has registered the spam probe email address in its own address book. However, the sender of the spam email in Paul cannot be considered a client of a local mail system. Even assuming,

arguendo, that the sender of the spam in email in Paul could be considered as such, then only that "client" has that email address in its address book. Certainly not all of the local clients of the system in Paul have spam probe email addresses in their respective address books.

This is in direct contrast to "registering a second address as a receiver address in an address table for mail virus detection, and a corresponding first address in a respective client mail address book, for each of a plurality of clients of the local mail system," as is recited in claim 1 of the present application. In Paul, spam probe email addresses are only placed on sites where spammers are likely to find them, such as chat rooms. Because Paul is attempting to stop the delivery of spam email to clients of the service, the spam probe email addresses are not affiliated with any local clients at all, but are simply "dummy" addresses set up so that the spam emails and spam email sources can be identified without a local client being in any way involved in the email transaction.

For example, in the system disclosed in Paul, if a mail virus were to be introduced to a client through an email addressed solely to that client (such as from a known source, or simply from a source which has not sent email to the spam probe email address), the mail virus could be spread to everyone in that client's address book through emails sent from the client. However, with the method recited in claim 1, the virus email from the client having the first address corresponding to the second address recorded in an address table for mail virus detection would be suppressed, and therefore not spread.

Therefore, the Applicants respectfully submit that Paul does not disclose or suggest at least the features of claim 1 discussed at length above. Further, as Tarbutton apparently merely discloses that unwanted mail includes not only spam, but also virus mail, the deficiencies of Paul in regard to claim 1 are not cured by Tarbutton. For a proper §103 rejection, the cited references must disclose all of the recited features of the rejected claim. Thus, as neither Paul nor Tarbutton, either alone or in combination, disclose or suggest at least these discussed recited features of claim 1, it is respectfully submitted that claim 1 patentably distinguishes over the cited references.

Further, the Applicants respectfully submit that even if, arguendo, the cited references did disclose all of the features of claim 1, there is no motivation to combine the cited references. MPEP § 2142 states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper." Here, the Examiner has simply stated, with no evidence to support the assertion, that "it would have been obvious to one skilled in the art to modify Paul....so that it is

used to not only protect against spam emails, but also virus emails." The Applicants respectfully submit that the simple fact that unwanted mail sometimes contains viruses as well as spam does not provide the requisite motivation. The system in Paul identifies emails to the spam probe email addresses, to stop them from being sent to other clients, regardless of the content of the email. Therefore, as the spam email is unwanted in toto, there would be no reason or motivation to find more unwanted properties of the emails. The Examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." Dembiczak, 50 USPQ2d at 1617. "The factual inquiry whether to combine the references must be thorough and searching." In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. Id. at 1433-34. The Examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

Therefore, for all of the reasons presented above, it is respectfully submitted that claim 1 patentably distinguishes over the cited references, and the withdrawal of the Examiner's rejection of claim 1 is respectfully requested.

Claims 2 and 8 depend from claim 1 and include all of the feature of that claim plus additional features which are not disclosed or suggested by the cited references. Therefore, it is respectfully submitted that claims 2 and 8 also patentably distinguish over the cited references.

Claims 4 and 7 of the present application, as amended, recite similar features to those discussed in regard to claim 1, and which are not disclosed or suggested by the cited references. Therefore, it is respectfully submitted that claims 4 and 7 also patentably distinguish over the cited references.

Claim 5 and 9-11 depend from claims 4 and 7, respectively, and include all of the features of those respective independent claims plus additional features which are not disclosed or suggested by the cited references. Therefore, it is respectfully submitted that claims 5 and 9-11 also patentably distinguish over the cited references.

On pages 7-8 of the Office Action the Examiner rejected claims 3 and 6 under 35 U.S.C.

§103(a) as being unpatentable over Paul in view of Tarbotton, and further in view of alleged common knowledge in the art and U.S. Patent No. 5,889,943, issued to Ji et al. (hereinafter referred to as "Ji"). The Applicants respectfully traverse the Examiner's rejections of these claims.

As previously discussed in this Amendment, claims 1 and 4 patentably distinguish over Paul and Tarbotton. Further, as Ji apparently merely discloses attaching virus electronic mail to a report electronic mail, and the alleged common knowledge merely discloses compressing electronic mail before sending, neither Ji nor the alleged common knowledge cure the deficiencies of Paul and Tarbotton in regard to claims 1 and 4. Therefore, as claim 3 depends from claim 1, and claim 6 depends from claim 4, and these dependent claims include all of the features of their respective independent claims plus additional features which are not disclosed or suggested by the cited references, it is respectfully submitted that claims 3 and 6 also patentably distinguish over the cited references.

Further, the Applicants respectfully submit that there is no motivation to combine Ji or the alleged common knowledge with Paul, because, as stated previously in this Amendment, there is also no motivation to combine Tarbotton with Paul, as Paul does not contemplate detecting nor reporting viruses, because Paul simply desires to stop any unwanted email addressed to spam probe addresses regardless of their content.

Summary

In accordance with the foregoing, claims 1-8 have been amended. No new matter has been presented. Thus, claims 1-11 remain pending and under consideration.

There being no further outstanding objections or rejections, it is respectfully submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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